

REMARKS

This Amendment, filed in reply to the Office Action dated November 23, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 7-8, 10-11 and 18-21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Shiraishi et al. (U.S.P. 4,617,468). Claims 7-8, 10-11 and 18-21 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Neriishi et al. (U.S.P. 6,746,840). Applicant respectfully traverses the rejection as follows.

With regard to the rejection under 35 U.S.C. § 102, the Examiner's rejection references the Board's Decision which construes the corresponding structure for the "means for obtaining information concerning the positions of the probes... and simultaneously detecting the management information..." as a stimuable phosphor sheet. The Examiner appears to construe the Decision as merely requiring the teaching of a stimuable phosphor sheet to support a rejection. This is incorrect. The Board's Decision faulted the prior rejection for failing to teach any means for simultaneously providing the position of the probes and the detection of the management information. Decision, page 6, first full paragraph, and last partial paragraph, lines 1-4. That same error is repeated here. The rejection also relies on double counting of elements, which is improper. Applicant submits that the anticipation rejection of independent claim 8 over Shiraishi is improper for at least the following four reasons.

First, contrary to the Examiner's rejection, Shiraishi does not teach the feature regarding simultaneous detection of position information for the probes and the management information. In making the rejection, the Examiner refers to the use of an electrophoretic gel as a means for attaching management information, and the stimuable phosphor as the means for obtaining the position information and simultaneously the management information. Applicant submits that the provision of the electrophetic gel merely comprises a technique to apply binding substances to the phosphor sheet that will be used for analysis. Therefore, the electrophetic gel does not provide any management information. See col. 1, lines 32-48. The electrophetic analysis is provided as a basis for locational information for binding sites, not management information. Col. 1, lines 48-52; col. 14, lines 44-48.

Second, claim 8 describes attaching management information to a predetermined location. The useful information of the electrophetic gel analysis depends on the location of a radioactive binding reaction. This is not in a *predetermined location* since the binding action necessarily varies in location.

Third, the Examiner's rejection impermissibly double counts the stimuable phosphor sheet as the means for obtaining the location and management information and also as the means for storing management information in association with the position probe information. The position probe information is obtained from the result of the electrophesis and read out by stimulating the phosphor sheet. Col. 14, line 55 to col. 15, line 23. Once read out, i.e. once the positional information is obtained, the energy stored in the phosphor sheet is depleted. Once

obtained, the information is no longer stored in the sheet. Therefore, the stimuable phosphor cannot provide both functions of obtaining and storing.

Fourth, the Examiner fails to identify the marker for the management information (as none is provided) that is the same or similar to the marker for the target substance. Therefore, the anticipation rejection of claim 8 over Shiraishi is deficient.

Because independent claims 11 and 20-21 also include the simultaneous detection, these claims are also patentable for the reasons set forth above. The remaining claims are patentable based on their dependency.

With further regard to claims 7 and 10, these claims describe searching through stored management information to obtain position information. The Examiner has not even indicated how this searching element is taught in Shiraishi. Applicant submits that such searching feature is not taught.

With further regard to claims 18 and 19, these claims describe more particularly the form of management information. Shiraishi fails to teach any of these aspects of these claims.

With regard to the anticipation rejection over Neriishi (assigned to Fuji Photo Film), Applicant submits that the priority date of the present application (December 28, 1999) is earlier than the effective filing date (July 24, 2000) of Neriishi. Therefore, Applicant may traverse this rejection by filing a verified translation of the priority document JP 1999-372925. That translation is submitted herewith.

Applicant adds claim 22 to describe the storing means as a computer memory device.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 09/749,752

Attorney Docket No.: Q61244

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

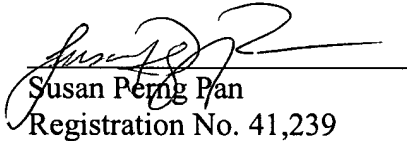
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Susan Perng Pan
Registration No. 41,239

Date: February 22, 2006

Enclosure: Verified translation of the priority document JP 1999-372925